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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,931	04/16/2004	Neil Barone	DAB-6	1605
7590 01/09/2006 Connolly Bove Lodge & Hutz LLP P.O. Box 2207 Wilmington, DE 19899-2207			EXAMINER MAH, CHUCK Y	
			ART UNIT 3677	PAPER NUMBER
DATE MAILED: 01/09/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/826,931	Applicant(s) BARONE, NEIL	
	Examiner Chuck Mah	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11 is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 13 and 15-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, the distance is defined without a measure unit (e.g. centimeter, inches etc.).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinberger '141.

'141 discloses the invention as claimed, including a U-shaped with vertical walls 52, 53, a spacing member 51, and a contact tip 56. '141 mounts the door stop on the top edge of the door instead of the bottom edge. The examiner takes Official Notice that attaching a removable door stop to the bottom edge of a door is well-known and common practice in the art. It would have been an obvious to

one skilled in the art to attach the removable door stop of '141 to the bottom edge of the door.

5. Claims 1-10, and 12, 13, and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita (5,010,622) in view of Weinberger '141.

'622 (figure 15) discloses the invention as claimed but for the U-shaped base portion for attachment to the door. '622 has a mounting portion (5") with a hole and a fastener for attachment. '141 teaches a removable doorstop having a U-shaped base portion to accommodate the different thicknesses and at the same time provide an easy separation of the door check from the door (col. 3, lines 20-49). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the door stop of '622 with a U-shape base portion as taught by '141 so that the door stop can be used to accommodate the different thicknesses and at the same time provide an easy separation of the door stop from the door.

As to claim 9, It would have been an obvious matter of design choice to form the distance between the walls of the U-shape base less or greater than $1 \frac{3}{8}$ inches, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

As to claim 10, "a period of non-use" is a broad term including the time during assembling or making. Hole 5a of '622 meets the limitation.

As to claim 12, it would have been an obvious matter of design choice to make the different portions of the spacing member round shape or whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

As to claim 17, it would have been obvious to one having ordinary skill in the art at the time the invention was made to mount the door stop around the bottom edge of the door, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

6. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita '622 and Weinberger '141 as applied to claims above, and further in view of Ventura (2,088,731).

'622 and '141 do not show a room wall having a molding in the path of motion of the door stop. '731 teaches a wall having a molding (24) in the path of motion of the door stop to provide support for attachment of the stop member. It would have been obvious to one of ordinary skill in the art at the time the invention was

made to attached the stop member of '622 to a molding as taught by '731 to provide a solid ground to support the attachment.

Allowable Subject Matter

7. Claim 11 is allowed.

Response to Arguments

8. Applicant's arguments filed Oct. 24, 2005 have been fully considered but they are not persuasive. Applicant's primary argument is based on that by attaching the door stop to the bottom edge of the door, the door stop would contact the molding of the wall and thereby causes no damage to the wall. This argument is not persuasive because (1). Attaching a door stop to the bottom edge of a door is known and common knowledge (see evidence in the cited references) and therefore it would have been obvious to one skill in the art. Mere recognition of additional advantages in prior art does not render nonobvious an otherwise known invention. *In re Wiseman*. 596 F.2d 1019, 201 USPQ 628 (CCPA 1979). (2). Again, take the advantage of the molding on the wall to provide a support for door stop is simply an old and known practice (see rejection of paragraph 6 and cited references). As to claim 10, "a period of non-use" is a board term that includes non-assembled condition. Morita simply meets the invention as claimed.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuck Mah whose telephone number is (571)272-7059. The examiner can normally be reached on 5/4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on (571)272-7075. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3677

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Chuck Mah
Primary Examiner
Art Unit 3677

CM